



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,788	06/28/2006	Oliver Winzenried	125542-1006	5003
32914 7590 07/27/2011 GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM ST DALLAS, TX 75201-4761				
EXAMINER				
COPPOLA, JACOB C				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
07/27/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,788

Applicant(s)

WINZENRIED ET AL

Examiner

JACOB C. COPPOLA

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13-15, 19, 20, 32, 34, 36, 37, 41-49, 53-59 and 61-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 13-15, 19, 20, 32, 62 and 63 is/are allowed.
- 6) ☒ Claim(s) 34, 36, 37, 41-49, 53-59 and 61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-532)
- 2) ☐ Notice of Draftsperson's Patent Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This Office Action is in reply to: 1) Applicants' response filed 11 May 2011 ("First 2011 May Response"), and 2) Applicants' response filed 24 May 2011 ("Second 2011 May Response").
2. Claims 11, 13-15, 19, 20, 32, 34, 36, 37, 41-49, 53-59, and 61-63 are pending and have been examined.
3. This Office Action is assigned Paper No. 20110722. This Paper No. is for reference purposes only.

Specification

4. The substitute specification filed 28 June 2006 is acknowledged and hereby entered.

Claim Rejections - 35 USC §112, First Paragraph

5. The following is a quotation of the first paragraph of 35 U.S.C. §112:

(a) The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 43-49 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

7. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Regarding Claims 43-49

8. Claim 43 recites (in part) “upon the dongle becoming lost or defective, sending the parameters to a central management computer, thereby causing the central management computer to send the parameters associated with authorization codes of a first of the at least two licensors only to a second computer associated with the first licensor and not sending to the second computer parameters associated with authorization codes of any of the other of the at least two licensors.”

9. The Examiner has carefully reviewed Applicants’ original disclosure and cannot locate support for an act of “sending the parameters to a central management computer, thereby causing the central management computer to send the parameters ... to a second computer associated with the first licensor.” The closest support appears to be in [0034], which recites “[t]he entire security file is sent to the central management computer during the process of restoring one or more authorization codes.” However, this does not support the limitations of “sending..., thereby causing the central management computer to send...” (emphasis added). In fact, in [0034], after the security file is sent, Applicants’ make clear that the “management server then reads the license parameters and the licensor from the security file,” however there is no indication that the sending of the security file is “thereby causing” the management computer to do anything, let alone causing it to send the parameters to the second computer. As described in

[0034], it is the management computer that causes the data to be sent to the second computer (*i.e.*, licensor), not the sending of the security files as claimed.

Claim Rejections - 35 USC §112, Second Paragraph

10. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 34, 36, 37, 41-49, 53-59, and 61 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claims 34, 36, 37, 41, and 42

12. Claim 34 recites (in part) “A computer readable medium, excluding signals, storing instructions that, when read by a computer, cause the computer to execute a process for restoring authorization codes assigned to a licensee by a plurality of licensors for a replacement dongle, the method comprising: storing on a first computer... the central management computer receiving” Claim 34 is indefinite because it is unclear whether the “first computer” is the “a computer” or the “central management computer” is the “a computer.”

13. The Examiner recommends redrafting the claim in the form of claim 53, which describes media having two processes: one performed by a first computer, and one performed by a central management computer.

Regarding Claims 43-49

14. Claim 43 recites (in part) “upon the dongle becoming lost or defective, sending the parameters to a central management computer, thereby causing the central management computer to send the parameters associated with authorization codes of a first of the at least two licensors only to a second computer associated with the first licensor and not sending to the second computer parameters associated with authorization codes of any of the other of the at least two licensors.”

15. Claim 43 is a method claim. Claim 43 is indefinite because it is unclear whether the “thereby causing the central management computer to send the parameters associated with authorization codes...” constitutes a method step required for anticipation/infringement or is the intended result of the positively recited step of “sending the parameters to a central management computer.”

16. Furthermore, in the case where the “causing...” does constitute a method step, claim 43 is indefinite because of the following reasons:

a. In addition to the limitation noted above, claim 43 also recites “after sending the license parameters, receiving a restored authorization code from...”

b. Claim 43 is indefinite because it is unclear whether the “after sending the parameters” is referring to the “sending the parameters to a central management computer” or the “thereby causing the central management computer to send the parameters...,” or to both.

Regarding Claims 53-59 and 61

17. Claim 53 recites (in part) “reading parameters from a first dongle...,” “receiving[,] at the central management computer[,] parameters,” and “sending parameters associated with authorization codes of a first of the at least two licensors only to a second computer....” First, claim 53 is indefinite because it is unclear whether the read parameters are the same as the parameters received at the central management computer. Second, claim 53 is indefinite because it is unclear whether the read parameters are the same as the parameters sent to the second computer. Third, claim 53 is indefinite because it is unclear whether the parameters received at the central management computer are the same as the parameters sent to the second computer.

18. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC §102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 43-49, as understood by the Examiner, are rejected under 35 U.S.C. §102(c) as being anticipated by Crounce et al. (U.S. 7,032,240 B1) (“Crounce”).

Regarding Claims 43-49

21. Crounce discloses reading parameters from a first dongle (“portable authorization device **140**”), which is connected via an interface (“host system interface circuit **145**”) to a first computer used by a licensee (“host system **110**”) and stores a plurality of original authorization codes from different ones of a plurality of licensors (“authorization information” from multiple vendors), each of the parameters being associated with one of the plurality of authorization codes and one of the plurality of licensors (“reconstruction data” associated with the multiple vendors) (see at least c. 5, ll. 17-34; c. 7, ll. 35-50; and c. 22, l. 55 – c. 23, l. 24); and storing on the first computer the parameters read from a first dongle (see at least c. 22, l. 55 – c. 23, l. 24). The remaining steps are met anytime the dongle is not lost or defective.

Claim Interpretation

22. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- c. *causing* “1. ... result[ing] in.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000; and
- d. *cause* “1. b. The one, such as a person, event, or condition, that is responsible for an action or result.” Id.

Allowable Subject Matter

23. Claims 11, 13-15, 19, 20, 32, 62, and 63 are allowed.

Response to Arguments

24. Applicants’ arguments with respect to the currently rejected claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

25. Applicants’ amendment filed in the First 2011 May Response necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE**

FINAL. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. Because this application is now final, Applicant are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, first paragraph written description and enablement, §112, second paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

28. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
22 July 2011

/JAMES A REAGAN/
Primary Examiner, Art Unit 3621